

REMARKS

Applicants appreciate the notification of allowable subject, i.e. that claim 16 would be allowable if re-written in independent form.

Claim 16 has been amended to provide further clarity. No new matter has been added.

It is also believed the amendment of claim 16 is properly entered at this time, i.e. after final rejection, because the amendment does not raise any new issues or require a new search. Entry of the amendment at this time is earnestly solicited.

The only outstanding rejection is of claims 12, 14-15 and 17-21 under 35 U.S.C 102(e) over commonly assigned Trefonas (U.S. Patent 6136501). The rejection is traversed.

Enclosed herewith is the Declaration of Peter Trefonas III, which establishes that the cited U.S. Patent 6136501 is not a reference under 35 U.S.C. 102(e) with respect to the present application.

In view thereof, reconsideration and withdrawal of the rejection are requested.

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,



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Docket No. 50351

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): P. Trefonas et al. **EXAMINER:** Y. Clarke
SERIAL NO.: 09/219,468 **GROUP:** 1752
FILED: December 28, 1998
FOR: PHOTORESIST COMPOSITIONS PARTICULARLY SUITABLE FOR
SHORT WAVELENGTH IMAGING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 CFR 1.132

The undersigned declares as follows:

1. I, Peter Trefonas III, am a co-inventor of the above-identified patent application (the "Application") which is assigned to the Shipley Company, L.L.C.

2. I understand that certain claims of the Application have been rejected by the patent Examiner in view of U.S. Patent 6,136,501, also assigned to Shipley Company, L.L.C. The co-inventors of U.S. Patent 6,136,501 are Peter Trefonas III, Gary N. Taylor and George G. Barclay. Of those co-inventors of U.S. Patent No. 6,136,501, Peter Trefonas III and Gary N. Taylor are co-inventors of the present Application.

3. As I further understand it, in the noted rejection of the Application based on the U.S. Patent 6,136,501, the Examiner has relied on disclosure relating to use of 1,8-diazabicyclo[5.4.0]undec-7-ene, particularly examples 22-36 of U.S. Patent 6,136,501. The use of 1,8-diazabicyclo[5.4.0]undec-7-ene disclosed in U.S. Patent 6,136,501 and the disclosure of use of a hindered amine such as diazabicyclo undecene or diazobicyclononene as set forth at column 12, lines 22-24 of U.S. Patent No. 6,136,501 was conceived and/or reduced to practice

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solely by me and/or Gary Taylor. The contributions of the additional co-inventor of George Barclay on U.S. Patent 6,136,501 were in areas other than use of 1,8-diazabicyclo[5.4.0]undec-7-ene and/or of a hindered amine photoresist additive such as diazabicyclo undecene or diazobicyclononene.

4. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title XVIII of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: Oct 15, 2004

Peter Trefonas III
Peter Trefonas III